

REMARKS

The application now contains new claims 3-40. Claims 28-40 are new. No amendments have been made. Applicant notes that claims 1 and 2 were previously cancelled.

Claims 3, 4, 8, 11-13, 16-18 and 25-27 stand rejected under 35 U.S.C. §102(b) as being anticipated by Sinofsky (US 5,071,417). Applicant respectfully traverses the rejection and submits that the reference does not provide a *prima facie* case of anticipation.

Claim 3 requires that at least the surrounding tissue be heated to a temperature that is elevated, but lower than the temperature of the target tissue. In Sinofsky, only the target tissue is heated. There is no mention of any heating of the surrounding tissue.

In Sinofsky there are two sources. However, only one of them does any substantial heating. The source 22, is no more than an illumination source and is described as being a broadband or white light source. Furthermore, there is no teaching of the illuminating source illuminating anything other than the target area, since illumination of other areas could be expected to cause errors and/or lack of sensitivity in the measurement.

Similarly, claim 4 requires that the target and the surrounding tissue be heated first to the lower temperature and that the selective heating of the target follow. In Sinofsky, there is only one act of heating, namely the heating of the target.

Claim 8 defines the heating of the surrounding tissue as using electromagnetic energy. However, there is no heating of the surrounding tissue by electromagnetic energy in Sinofsky, in which the electromagnetic energy heats only the target area.

Claim 25 defines two sources of electromagnetic energy to heat the surface. As indicated above, only the laser source in Sinofsky heats tissue and there is certainly no source that is "adapted to heat at least tissue surrounding the target to a first temperature above normal body temperature."

The claims not specifically mentioned are not *prima facie* anticipated at least for the same reasons as their parent claims.

Claims 5-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sinofsky. Applicant respectfully traverses the rejection.

As a preliminary matter, claims 5-7 are not *prima facie* obvious in view of Sinofsky, for the reasons given above with respect to their parent claim 3.

In addition, even accepting the Examiner's statement of the law, the question of optimization has to be considered in the context of the Sinofsky reference. This reference does

not teach that low temperature materials can be used. In fact, the teaching is to fuse either the tissue itself or the covering material. Applicant submits that if the covering material is used and it is a low temperature fusing material, then as follows from the disclosure of Sinofsky at col. 3, lines 49-50, the depth of the heating would be limited to the depth of the covering and there would not be any heating of the skin at all. If no covering material is used and the fusing of the tissue itself is desired, then applicant submits that the Examiner has not shown that the temperatures given in claims 5-7 are in fact sufficient to cause the fusion called for in the method of *Sinofsky*.

Applicant notes that claim 9 has not been rejected over the art.

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Sinofsky in view of Bayer et al. As a preliminary matter, claim 10 is not *prima facie* obvious in view of Sinofsky, for the reasons given above with respect to its parent claim 10.

However, claim 10 is not *prima facie* obvious for another reason. The Examiner's rejection is based on the obviousness of pulsing the light, in *Sinofsky* as taught in Beyer "depending on the type of treatment being performed." Applicant submits that this reasoning is improper in rejecting claim 10. In order to find claim 10 obvious in view of the combination as stated, it would have had to be obvious to replace the continuous laser of Sinofsky with pulsed light *for the purpose of Sinofsky*. Sinofsky defines the power levels need for the sole treatment that he discusses. These power levels are easily achieved by CW lasers and using a pulsed laser would only complicate (and increase the cost of) the system, with no benefit. This is certainly not an obvious combination.

Claims 14, 15 and 19-24 stand rejected as being unpatentable under 35 U.S.C. §103(a) over Sinofsky in view of Shain.

As a preliminary matter, claims 14, 15 and 19-24 are not *prima facie* obvious in view of Sinofsky, for the reasons given above with respect to their parent claim 3.

However, at least some of these claims are not *prima facie* obvious for additional reasons.

As to claims 14, 15, 19 and 20, the Examiner contends that it would have been obvious to use the broadband source of Shain in the method of Sinofsky. Applicant respectfully disagrees.

While Sinofsky does not provide information as to the width of his beam, it is quite clear from the Figures that an important element of his device is the size of the

beam and the possibility of fusing fine lines of tissue of coagulating material. A person of ordinary skill in the art would not have used a pulsed broadband source for the use defined by Sinofsky, which requires much higher accuracy than does that of Shain.

As to claims 21 and 22, applicant can find no teaching in either Shain or Sinofsky of both a target area and a surrounding area. Shain does, in fact teach a two step heating process. However, the heating in both cases appears to be exactly of the same area. Thus, the limitations of claim 21 and claim 22 are not met by the combination.

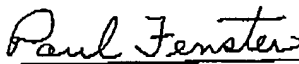
As to claims 23 and 24, Neither Sinofsky nor Shain teach using the devices described for either dermatological treatment or hair removal. In fact, it is questionable how the devices described in these references alone or in some unnamed combination could be used for hair removal or dermatological treatment.

New claims 28-~~40~~ and especially independent claim 28 provide a different wording for defining the invention. In general, the arguments given above apply to corresponding claims.

As to the double patenting rejection, applicant will file a terminal disclaimer when patentable subject matter is indicated in the application.

In view of the above remarks, applicant submits that the claims are patentable and that the application is ready for allowance. Notice to that effect is respectfully solicited.

Respectfully submitted,
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